

ESTTA Tracking number: **ESTTA666177**

Filing date: **04/13/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79133133
Applicant	FAVORIT CZECHOSLOVAKIA s.r.o.
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Submission	Appeal Brief
Attachments	TTAB_Ex Parte Appeal Brief_Favorit.pdf(130106 bytes )
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In re:	)
	)
Serial No. 79133133	)
	)
Applicant: FAVORIT CZECHOSLOVAKIA s.r.o.	)
	)
Filed: January 17, 2013	)
	)
Mark: FAVORIT	)
	)

**APPLICANT'S APPEAL BRIEF**

Applicant, FAVORIT CZECHOSLOVAKIA s.r.o., a limited liability company of the Czech Republic, hereby appeals to the Trademark Trial and Appeal Board from the Examining Attorney's Final refusal of registration dated November 15, 2014 and continued final refusal of January 21, 2015.

**FACTS OF THE CASE**

On January 17, 2013, Applicant filed a trademark application for the mark FAVORIT (and design) in connection with goods in classes 012, 025, and 028.

On August 4, 2013, the Examining Attorney issued a non-final office action for class 012 and 028 only. The goods in class 012 are "bicycles, namely road bikes, mountain bikes, cross bikes, trekking bikes, racing bikes, sports bikes, freestyle bikes, children's bikes, and construction bikes; bicycle parts, namely frames, wheels, forks, handlebars, mudguards, saddles, seat posts, chains, gears, pedals, and rims for bicycle wheels; luggage nets for vehicles; handlebar attachments, namely bicycle mirrors, brakes, and bells; bicycle cranks, tyres, casings for pneumatic tires, inner tubes for bicycles,

tubeless tyres for bicycles; repair equipment for inner tubes, namely, tire repair patches, adhesive rubber patches for repairing inner tubes, baskets adapted for bicycles, water bottle holders for bicycles, stands for bicycles, bicycle racks for vehicles.” The goods in class 028 are “playing cards; stationary exercise bicycles; sports training apparatus, namely portable stationary cycles and spring hand grips for bicycles; toy scooters; manually-operated exercise equipment for physical fitness purposes; body building apparatus, body training apparatus, sports training apparatus, namely pitching machines.”

On August 4, 2013, the Examining Attorney issued a likelihood of confusion of classes 012 and 028 only. The cited mark was registration no. 2661941 for “FAVORITES” in connection with “mail order catalogs featuring jewelry, hardware, sporting goods, toys and games, food and home furnishings, namely, furniture, appliances, housewares, home accessories, domestics, textile goods, electrical appliances, and electronics,” in class 016. The Examining Attorney argued that the marks are essentially the same, a variation of the term FAVORITE, the word portion of applicant’s mark is more likely to be impressed upon a purchaser’s memory, and applicant’s goods are the type of goods identified in registrant’s mail order catalogs.”

On February 7, 2014, applicant filed a response arguing that the marks are not similar when considered in their entirety because the cited mark contains the two additional letters “ES” at the end, contrasted with applicant’s design feature, and that these differences are significant because the word “FAVORITE” is a weak term in classes 012 and 028.

On March 16, 2014, the Examining Attorney suspended the application pending the disposition of a prior pending application, and maintained the refusal based on a likelihood of confusion with registration no. 2661941.

On November 15, 2014, the Examining Attorney issued a final refusal, indicating that the prior pending application had abandoned. The Examining Attorney responded by arguing that even weak marks are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. However, this time, instead of limiting the likelihood of confusion to classes 012 and 028, the Examining Attorney issued a general refusal based on a likelihood of confusion with registration no. 2661941. With regard to class 025, the Examining Attorney argued that registration no. 2661941 also refers to “textile goods” which encompasses clothing.

On December 2, 2014, applicant filed a Request for Reconsideration arguing that the Examining Attorney accords OVERLY BROAD protection for a very weak mark. Applicant argued that based on the Examining Attorney’s arguments, it would never be possible to register a mark that sounds like “FAVORITES,” even in the singular form, in connection with “jewelry” (class 014), hardware (class 006), sporting goods, toys and games (class 028, food (classes 029, 030, 031, 032,)), furniture (class 020), appliances, housewares, home accessories, domestics (class 007, 011, 021), textiles (class 022, 023, 024, 025), electrical appliances, and electronics (class 009). This is because registration no. 2661941 also involves mail mail catalogs featuring all of these goods. Applicant attached evidence of weakness in class 025.

On January 21, 2015, the Examining Attorney withdrew the refusal based on a likelihood of confusion in class 025, but maintained the likelihood of confusion refusal in classes 012 and 028, with no new arguments. Instead, the Examining Attorney attached third-party registrations tending to show that applicant's and registrant's goods are the type that may emanate from the same source.

### ISSUE TO BE DECIDED

1. Whether Applicant's mark, below, in connection with goods in classes 012 and 028, is likely to be confused with registrant's mark, FAVORITES (standard character) in connection with mail order catalogs in class 016.



### ARGUMENTS

#### A. Applicant's mark must be viewed in its Entirety

The Examining Attorney must consider the trademarks in their entirety to determine whether or not there may be a likelihood of confusion. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 3 USPQ2d 1442, 1445 (8th Cir. 1987). Further, a likelihood of confusion may not be predicated on only part of a mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). See *Opryland USA Inc. v. Great*

*American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992) (stating that marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight).

Moreover, while it is often true that the word portion of a mark is more likely to be impressed upon a purchaser's memory, that is not the case in every situation. *See In re Electrolyte Laboratories*, 16 U.S.P.Q.2d 1239 (CCPA 1990) (stating that there is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue). Nevertheless, no element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone. *Id.*; *See also Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 U.S.P.Q. (CCPA 1974).

Applicant's mark consists of the word FAVORIT in a stylized fashion, while the registered mark contains the wording FAVORITES. The registered mark contains the additional two letters "ES" contrasted with the applicant's design feature and applicant's obvious misspelling of the word FAVORITE, making the mark also appear as a combination of the two words "FAVOR IT."

While these differences may appear minor to some, they are significant in cases where a mark is weak or commonly used. Where a mark or a portion of a mark is so commonly used, the importance of additional elements (such as or words or designs) included in the mark are significantly increased because the public will look to such other elements to distinguish the source of the goods or services. *See, e.g., AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

The wording FAVORITES is a terribly weak mark as evidenced by the evidence of record, consisting of four (4) third-party registrations containing the word “FAVORITE” in class 012 and ten (10) third-party registrations containing the word “FAVORITE” in class 028 [out of a possible 21]. Applicant further attaches 3 third-party websites containing the word “FAVORITE” in connection with toys (class 028) and 3 third-party websites containing the word “FAVORITE” in connection with bicycles (class 012).

In sum, while applicant’s goods may be of the type that are sold through registrant’s mail catalogs, consumers are not likely going to believe there is a common source because (a) the wording “FAVORITES” is commonly used, (b) the marks FAVORIT and FAVORITES are not identical, and (c) one of the two words is obviously misspelled, making applicant’s mark appear as a combination of two words: FAVOR IT.

### **CONCLUSION**

WHEREFORE, Applicant prays that the Examining Attorney’s refusal of classes 012 and 028 be reversed and that registration be granted for all classes.

Submitted: April 13, 2015

By: \_\_\_\_\_/John Alumit/\_\_\_\_\_

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